

REMARKS

Reconsideration and withdrawal of the restriction requirement and election of species is respectfully requested in view of the remarks herewith, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1-47 are pending in this application. Claims 1-46 are original, and claim 47 has been newly added in this application, without prejudice, without admission, without surrender of subject matter, and without any intention of creating any estoppel as to equivalents.

No new matter has been added.

It is submitted that the claims as originally presented were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as previously presented, were not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, this amendment was made to round out the scope of protection to which Applicant is entitled. Support for new claim 47 can be found in the specification, for example, in Example 1.

II. RESPONSE TO RESTRICTION REQUIREMENT

The April 18, 2006 Office Action required an election of a single Group of claims under 35 U.S.C. § 121 from among the following:

- I. Claims 1-25 and 40, drawn to a method of identifying peptides that bind to agents that have SOD activity, such as Abeta which is bound to a copper ion, classified in class 435, subclass 7.2;
- II. Claims 26-39 and 45, drawn to the product identified and polynucleotide encoding it, classified in class 514, subclass 2;
- III. Claims 41-44, drawn to a method of inhibiting SOD activity by administering the peptide of Group II, classified in class 514, subclass 2; and,
- IV. Claim 46, drawn to a method of identifying peptides that bind to a zinc binding agent, classified in class 435, subclass 7.2.

The claims of Group II, encompassing claims 26-39 and newly added claim 47, are

elected with traverse for further prosecution in this application. Applicants reserve the right to file divisional applications to non-elected subject matter.

The Office Action further required an election of species.

Applicant elects, with traverse, the species corresponding to SEQ ID NO:3.

As a traverse, it is noted that the MPEP lists two criteria for a proper restriction requirement. First, the inventions must be independent or distinct. (MPEP § 803) Second, searching the additional inventions must constitute an undue burden on the Examiner if restriction is not required. *Id.* The MPEP directs the Examiner to search and examine an entire application “[i]f the search and examination of an entire application can be made without serious burden, ...even though it includes claims to distinct or independent inventions.” *Id.*

It is respectfully submitted that the criteria listed in MPEP § 803 have not been met in this case, as no showing has been made that an undue burden would be placed on the Examiner. The present application relates to methods for isolating candidate peptides for treatment of a disease caused by an agent with SOD activity, the peptides resulting from these methods, and methods related to the purpose of these peptides. Accordingly, there is a relationship among all methods and peptides disclosed in the present invention.

Indeed, any search for the methods of Group I will certainly encompass references for Group II and III. The claims of Group I present criteria that are involved in finding peptides for treating a disease associated with SOD activity or copper binding-induced toxicity. The claims of Group II re-introduce these criteria as characteristics of the claimed peptides. Furthermore, the methods of Group III involve peptides with the same criteria and characteristics of Groups I and II. Therefore, it is respectfully submitted that it would not place an unnecessary burden on the Examiner to search and examine Groups I-III together, as a search for the Group I methods would necessarily include Groups II and III.

Furthermore, for a restriction requirement to be proper, it must satisfy both of the above elements. Accordingly, the present restriction requirement is improper and must be withdrawn because the Office Action only alleges that the inventions are distinct, as described above. The Office Action provides no showing that search and examination of the claims would be an undue and serious burden, nor does the Office Action show that at the very least, the search and examination of the claims of Groups II and III, or of Groups I and IV (which are similarly

classified in class 514, subclass 2 or class 435, subclass 7.2, respectively) would be an undue and serious burden. Therefore, the restriction requirement is improper because it does not satisfy both requirements for restriction and should be withdrawn.

Furthermore, Applicant respectfully traverses the election of species.

M.P.E.P. § 808.01(a), states that “where there is no disclosure of relationship between species (see M.P.E.P. §806.04 (b)), they are independent inventions and election of one invention” is required. In view of M.P.E.P. §803, however, when the generic claim includes sufficiently few species that a search and examination of all the species at one time would not impose a serious burden on the examiner, then a requirement for election is inappropriate.

It is respectfully submitted that there is a disclosed relationship between the species as the species from which election was required include a small number of peptides which are all interrelated as they share a similar function. Therefore, reconsideration and withdrawal of the election of species requirement are requested.

Enforcing the present restriction requirement and election of species would result in inefficiencies and unnecessary expenditures by both the Applicants and the PTO, as well as extreme prejudice to Applicants (particularly in view of GATT, a shortened patent term may result in any divisional applications filed). Restriction has not been shown to be proper, especially since the requisite showing of serious burden has not been made in the Office Action and there are relationships between the claimed combinations. Indeed, the search and examination of at least Groups II and III would involve such interrelated art that the search and examination of at least Groups II and III can be made without undue burden on the Examiner. All of the preceding, therefore, mitigate against restriction.

In view of the above, reconsideration and withdrawal of the Requirement for Restriction and election of species are requested, and an early action on the merits earnestly solicited.

Respectfully submitted,

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